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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/647,934 | 08/25/2003 | Troy A. Dalsing | DALS001 | 3457 |
| 25235 | 7590 | 12/13/2005 | EXAMINER | |
| HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEENTH ST DENVER, CO 80202 | | | JOHNSON, JERROLD D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |
| DATE MAILED: 12/13/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,934

Applicant(s)

DALSING ET AL.

Examiner

Jerrold Johnson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 25 Aug 2003

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a product, classified in class 206, subclass 5.1.
- II. Claims 15-20, drawn to method of storing a material, classified in class 134, subclass 901.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product that does not involve sterilization.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michael Martinson on Nov. 09, 2005 a provisional election was made without traverse to prosecute the invention of the product, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The inventions are distinct, each from the other because of the following reasons:

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

Claim 11 is also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is an improper hybrid claim, as it is a method step written as a product claim. Claim 11 should be cancelled or included with the withdrawn method claims.

Claim 13 is improper, as it suggests that the base unit is no longer part of the claimed combination. Accordingly, claim 13 contradicts claim 1, to which it depends, and should be cancelled.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Muckenhirn EP 416164.

Muckenhirn discloses a reusable container for storing contact lenses of a type which is notoriously known for to also be used for the sterilizing contact lenses as well, and inherently discloses this process.

Re claim 1, the container includes a lid 1, a chamber 4, and a base unit 8. The chamber includes a base unit attachment 6, for attachment of the chamber to the base unit.

Re claim 4, Muckenhirn discloses 2 chambers.

Re claim 6, the mere opening of the lid of Muckenhirn provides tamper evidence.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muckenhirn EP 416164.

Re claims 10-12, Muckenhirn explicitly discloses the chamber convex shape and the use with a contact lens, and implicitly discloses the method step of sterilizing the contact lens.

Muckenhirn does not explicitly show a contact lens.

It would be, of course, obvious to one of ordinary skill in the art to provide the container of Muckenhirn with contact lenses, as that is its purpose.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muckenhirn EP 416164 in view of Kroupa US 6,435,339.

Contact lens container include either threaded on caps like Muckenhirn or hinged lids. Kroupa discloses the art recognized interchangeability of these two structures.

Accordingly it would have been obvious to one of ordinary skill in the art to modify the container of Muckenhirn with a lid connected through a hinge (flexible member) so as to provide a means through which the lids can not be lost.

Claim 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muckenhirn EP 416164.

Muckenhirn discloses a base unit attachment having resilient arms that couple with an opening in the base unit.

This is the opposite arrangement of the present invention set forth in claim 3. However, one of ordinary skill in the art would recognize the obvious solution of reversing the parts of the chamber and the base unit. One would be motivated to do this so as to provide a chamber that would be more stable when it is detached from the base unit and is self-supported.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muckenhirn EP 416164.

Muckenhirn discloses a base unit accommodating two chambers.

One of ordinary skill in the art would recognize that the concept set forth in Muckenhirn could easily be replicated for a greater number of chambers.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muckenhirn EP 416164 in view of Nakao et al. US 2001/0019022 or Bennett US 5,224,593.

Muckenhirn does not disclose a tamper evident lid having a tear strip.

Both Nakao and Bennett disclose tamper evident tear strips that become irreversibly removed from the lid before the container is opened.

Although neither Nakao nor Bennett disclose the exact tear strip configuration set forth in the present application, both disclose a structure that meets the claim language. Additionally, the tear strip structure set forth in the present application is a well known art recognized equivalent to the equally well known structures shown by Nakao and Bennett. Accordingly, to substitute the structure set forth in the present application for that shown by Nakao or Bennett would also be obvious.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muckenhirn EP 416164 in view of Figari US 4,784,258.

Muckenhirn does not disclose a magnifying lens in his lid.

Figari discloses this arrangement.

Accordingly, it would have been obvious to have provided the lid of Muckenhirn with the magnifying lens of Figari so that the user of the container can view the contents of the container when the lid is disposed on the container.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muckenhirn EP 416164 in view of Ryder US 4,823,944 or Stalcup US 3,089,500.

Muckenhirn does not disclose another separate container.

Stalcup discloses attaching the chamber 14 to a container 10 through elements 32.

Ryder discloses an arrangement where the entire contact lens container is disposed within another container 30.

Accordingly, it would have been obvious to couple the chambers of Muckenhirn to another container so as to protect the chamber from damage such as during travel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ 



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